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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,773	02/05/2002	Akira Shibata	SHO 1008-01US	7568

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THE LAW OFFICE OF JOHN A. GRIECCI
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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/068,773

Applicant(s)

SHIBATA ET AL.

Examiner

Victor S Chang

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11 and 13-20 is/are allowed.
- 6) ☒ Claim(s) 1-10 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 11/22/2004. Applicants' amendments to the claims 1, 3, 7, 11, 16, 20 and 21, cancellation of claim 12 have all been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, as pointed out by Applicants that a replacement sheet that included a legend designating Figure 11(A) as prior art was supplied in an Amendment dated November 4, 2003, the objection to the drawings in section 5 of Office action dated 7/13/2004 is withdrawn. Additionally, the Examiner acknowledges that a certified translation of priority document JP 2001-028776 was supplied in a response dated May 5, 2004, and the rejection over the O'Conner et al. reference in section 8 of Office action dated 7/13/2004 is also withdrawn.

Claim Rejections - 35 USC § 112

4. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to newly amended claim 1, while the amendment overcomes prior rejection over the term "configured", the Examiner repeats (see Office action dated

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7/13/2004, page 3) that the phrase “adds to ...” at line 12 still appears to be vague and indefinite, because it provides no means by which the function is expected to be accomplished.

Rejections Based on Prior Art

5. Claims 1-10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 3-85886 (English translation) in view of JP 2000025869 (Derwent Abstract), and further in view of JP 9-86569 (English translation), generally as set forth in section 7 of Office action dated 7/13/2004.

For the purpose of clarification, the Examiner repeats the relied upon prior art as follows: JP ‘886 is directed to a liquid absorption sheet for food, which is a laminate of an absorption sheet layer and a porous plastic sheet which has numerous three-dimensional apertures (holes) to guide drips oozing from the food to the absorption sheet (page 1, lines 7-11). The absorption sheet contains a freshness preservative for maintaining the freshness of the food (page 1, lines 23-25). Further, JP ‘886 teaches that “the apparent thickness of said porous plastic sheet including the three-dimensional apertures is four times or more the thickness of said plastic sheet itself” (page 1, lines 14-16), which is taken to be admitted prior art by the Examiner as implicitly teaching the hollow cavity under the surface of the convex portion of the surface sheet of the instant invention, as stated in the prior Office action (see Office action dated 7/13/2004, page 7, top paragraph), because Applicants failed to traverse the Examiner’s position in the prior Office action. The Examiner would like to again suggest that Applicants may wish

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to provide a copy of full translation of JP '886, so as to clarify the scope of this prior art reference.

It is noted that newly amended independent claim 1 now includes structural elements of the porous surface sheet.

With respect to the amended claim 1, the Examiner repeats (see Office action dated 7/13/2004, page 4) that although JP '886 lacks an express teaching that the absorption sheet is breathable, it is noted that the invention of JP '869 is also directed to a food tray mat, and JP '869 teaches a mat which has holes to drain waste water (inherently at bottom of the sheet for draining), and that the freshness of fish is maintained for a long time by an absorbent tray mat with holes which is air permeable (breathable, which measurable by ventilation resistance). As such, it would have been obvious to one of ordinary skill in the art to modify the apertures (holes) of JP '886, so as to provide a suitable air permeability (breathability), motivated by the desire to obtain an improved absorption sheet which maintains the color and freshness in food for a long time. As to the breathability in both horizontal and thickness directions, in the absence of unexpected results, since the combined teachings of prior art is directed to the same subject matter (a breathable laminate of absorption sheet and porous surface sheet of three-dimensional apertures (holes) at the bottom) as the instantly claimed invention, it is the Examiner's position that suitable air permeability (or breathability) in both the horizontal and thickness direction is an obvious optimization to one of ordinary skill in the art, motivated by the desire to maintain the freshness of the food. It should be noted that where the claimed and prior art products are identical or substantially identical in

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structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. See MPEP § 2112.01. Finally, the Examiner repeats that “adds to breathability ...” is a relative terminology that is neither qualified or quantified. Thus holes in the prior art devices serve to meet the broad and vague claim limitations.

For newly amended claims 3 and 7, the Examiner repeats (see Office action dated 7/13/2004, page 6) that although JP ‘886 does not expressly teach that the laminated absorption sheet is used as a tray mat, it is noted that Applicants have expressly admitted that JP ‘886 is used as a food drip tray mat (specification, page 1, bottom paragraph).

For newly amended independent claim 21, the Examiner repeats that JP ‘886 is directed to a liquid absorption sheet for food, which is a laminate of an absorption sheet layer and a porous plastic sheet which has numerous three-dimensional apertures (holes) to guide drips oozing from the food to the absorption sheet (page 1, lines 7-11), as set forth above. As to the breathability in both horizontal and thickness directions, in the absence of unexpected results, the Examiner repeats, as set forth above, that since the combined teachings of prior art is directed to the same subject matter (a breathable laminate of absorption sheet and porous surface sheet of three-dimensional apertures (holes) at the bottom) as the instantly claimed invention, it is the Examiner’s position that suitable air permeability (or breathability) in both the horizontal and thickness direction is an obvious optimization to one of ordinary skill in the art, motivated by the desire to maintain the freshness of the food.

Response to Amendment

6. Applicants' argument "Because the cited art fails to teach or suggest the absorption mat as recited in claim 1, the cited references fail to establish a prima facie case of obviousness" (Remarks, page 11, first paragraph) has been carefully considered, but is not persuasive. More particularly, since the combined teachings of prior art is directed to the same subject matter (a breathable laminate of absorption sheet and porous surface sheet of three-dimensional apertures (holes) at the bottom) as the instantly claimed invention, it is the Examiner's position that suitable air permeability (or breathability) in both the horizontal and thickness direction is an obvious optimization to one of ordinary skill in the art, motivated by the desire to maintain the freshness of the food, Applicants argument to the contrary notwithstanding.

With respect to Applicants' argument "there is no indication in JP '886 of any air permeability in the thickness direction of the absorption sheet. There are, however, pores in the plastic (cover) sheet. Modifying these holes in the plastic cover sheet would not create air permeability in the thickness direction of the absorption sheet" (Remarks, page 11, third paragraph), the Examiner notes that Applicants clearly argue the cited references individually. In response to Applicant's arguments, it is asserted that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. It should be noted that the combined teachings of JP '886 and JP '869, as set forth above, render the instantly claimed invention obvious. Further, the Examiner notes that since the porous surface

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sheet of instant invention is also a three-dimensional cover sheet, Applicants appear to be arguing that the instant invention would not be air permeable as well. Finally, the Examiner notes that Applicants fail to provide any evidentiary support for the aforementioned argument, and it should be noted that Attorney arguments cannot take the place of evidence.

Allowable Subject Matter

7. Claims 11 and 13-20 are allowable over prior art.

The following is a statement of reasons for the indication of allowable subject matter: It is noted that newly amended independent claim 11 clarifies the structural elements of a terminal portion as being "adjacent to the minute aperture and the terminal portion forms a notched edge so as to facilitate air flow". The Examiner notes that the structural feature of the terminal portion, which promotes air ventilation in horizontal direction, of instant invention is neither obvious, nor taught by cited prior art references.

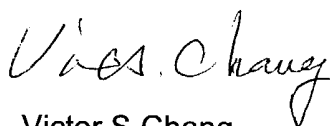
Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Victor S Chang
Examiner
Art Unit 1771

1/6/2005